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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,771	03/16/2000	JINKO KIMURA	500.38296X00	8406

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EXAMINER

THORNTON, YVETTE C

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/508,771

Applicant(s)

KIMURA ET AL.

Examiner

Yvette C. Thornton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 21-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The request filed on December 11, 2002 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 09/508771 is acceptable and a RCE has been established. An action on the RCE follows.

Response to Amendment

2. The examiner notes that the claims as written do not require fish eyes to be present. The specification indicates that 5 fish eyes/m² or less is required. The examiner notes that claims 1, 19 and 36 contain the limitation that the fish eyes in, "protecting film (C) does not exceed 5 fish eyes/m² when measured under a microscope at a multiplication of 100", which is a process limitation that does not further define the claimed product. Claim 36 further comprises the limitation that the "generation of air voids" in the photosensitive layer (B) "does not exceed 5 air voids/m² when measure under a microscope at a multiplication of 100 following the lamination of the photosensitive film and removal of the protecting film", which is also a process limitation. Consequently, the burden shifts to Applicant to provide evidence of an unobvious difference between the claimed product and the prior art. Furthermore, "The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. In re Fessmann, 180 USPQ 324,326 (CCPA 1974), see MPEP 2113.

3. Furthermore, the examiner is of the position that when the protecting layer has fish eyes in the claimed range, the photosensitive layer would inherently have air voids in the claimed range after removal of the protecting film and lamination of the photosensitive film.

4. The following rejections are based on the above interpretations of the claims.

Claim Rejections - 35 USC § 103

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 7-10, 13-14, 18-19, 21-25, 28-29, 31 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hilger (US 4698292) in view of Fifield (DE 3825782A, translation).

Hilger teaches a photopolymerizable recording material comprising a transparent support film, a thermoplastic photopolymerizable photoresist layer and a flexible covering film on the exposed surface of the photoresist layer (abstract). Hilger teaches that the said support preferably has a thickness in the range of 15-30 μm , and the covering film has a thickness from about 5-25 μm . The principal constituents of the photopolymerizable layer comprise a thermoplastic polymeric binder, polymerizable compounds, which are preferably (meth)acrylic acid esters of polyhydric aliphatic hydroxyl compounds and a photoinitiator. The thickness of the layer is generally in the range of between 10-100 μm , most preferably between 15-70 μm . Example 1 exemplifies a 25 μm thick polyethylene terphthalate film coated with a photopolymerizable layer having the a composition comprising a terpolymer of n-hexylmethacrylate, methacrylic acid and styrene which has a molecular weight of about 35,000. A 12 μm thick polyethylene film was then applied by laminating to the surface of the dry film layer. The laminate obtained was stored in a large-size roll. Although, example 1 exemplifies the use of a 40 μm thick photopolymerizable layer, Hilger teaches that the preferred range is between 15-70 μm . It would have been obvious to one of ordinary skill in the art to use a thickness within the preferred to make the photopolymerizable layer. It is the examiner's position that between 15-30 μm , the limitations of the instant claims are met.

Hilger teaches all the limitations of the claims except it fails to lack explicit details pertaining to the protective or covering film. The prior art of Fifield teaches that a covering film, which contains less gell and fewer inclusions would reduce the number of indentations in the resist and form a roll that is more even (pg. 11, l. 3-9). Fifield teaches that suitable materials for the cover film are polyamide, polyester vinyl film or a film of cellulose ester (pg. 8, l. 3-7). The examiner is of the position that gell and inclusions are analogous to fish eyes as defined by the applicant. One of ordinary skill in the art would have been motivated by the teachings of Fifield to substitute a material such as polyamide, polyester vinyl film or a film of cellulose ester for the low density polyethylene covering of Hilger in order to make the roll of Hilger more even and the resist have a reduced number of indentations. It would have been obvious to one of ordinary skill to make as few inclusions as possible and the determination of optimal results can be achieved by routine experimentation. It is the examiner's position that when the covering of Hilger is optimized as taught by Fifield, the final product will inherently meet the limitation of the claimed invention in regard to the diameter and number of fish eyes per m². Furthermore, the examiner is of the position that when the protecting layer has fish eyes in the claimed range, the photosensitive layer would inherently have air voids in the claimed range after removal of the protecting film and lamination of the photosensitive film.

7. Claims 1-10, 13-19, 21-25 and 28-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taguchi (US 4360582) in view of Fifield (DE 3825782, translation). Taguchi teaches a photopolymerizable element comprising a layer of a photopolymerizable composition and a film support made of a transparent material. In order to produce a resist image on a substrate, the photopolymerizable layer is applied to a substrate, exposed imagewise to actinic radiation and developed to form an image (c. 3, l. 20-46). The said element may further comprise a strippable protective film provided on the other surface of the photopolymerizable composition layer for preventing blocking at the winding step and adhesion of dust during handling (c. 3, l. 62-68).

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Appropriate materials for the said protective film include polyethylene terephthalate, polypropylene film, polyethylene film, cellulose triacetate film, polyamide and polyethylene laminated paper (c. 10, l. 15-23). Taguchi teaches that the thinner the photopolymerizable layer, the more the resolution is improved (c. 9, l. 17-19). Example 1 exemplifies a solution comprising poly(methyl methacrylate) as an organic binder, a photopolymerization monomer, and a photoinitiator coating onto a 50 μ -thick polypropylene film and dried to form a photopolymerizable layer having a dry thickness of 10 μ . The said layer was then laminated onto a 20 μ -thick poly(methyl methacrylate) support film. The polypropylene film was then stripped and the said layer was laminated to a treated copper-clad epoxy resin fiberglass substrate. The formed element was then exposed to actinic rays and developed to form a negative image. An etching process was then preformed to remove the copper at the areas unprotected by the resist image (c. 16, l. 30-c. 17, l. 17).

Taguchi teaches all the limitations of the claims except it fails to lack explicit details pertaining to the protective film. The prior art of Fifield teaches that a covering film, which contains less gell and fewer inclusions would reduce the number of indentations in the resist and form a roll that is more even (pg. 11, l. 3-9). Fifield teaches that suitable materials for the cover film are polyamide, polyester vinyl film or a film of cellulose ester (pg. 8, l. 3-7). The examiner is of the position that gell and inclusions are analogous to fish eyes as defined by the applicant. One of ordinary skill in the art would have been motivated by the teachings of Fifield to substitute a material such as polyamide, polyester vinyl film or a film of cellulose ester for to make the exemplified polypropylene protective layer of Taguchi in order to make the element of Taguchi more even and the resist have a reduced number of indentations. It would have been obvious to one of ordinary skill to make as few inclusions as possible and the determination of optimal results can be achieved by routine experimentation. It is the examiner's position that when the protective film of Taguchi is optimized as taught by Fifield, the final product will inherently meet the limitation of the claimed invention in regard to the diameter and

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number of fish eyes per m². Furthermore, the examiner is of the position that when the protecting layer has fish eyes in the claimed range, the photosensitive layer would inherently have air voids in the claimed range after removal of the protecting film and lamination of the photosensitive film.

8. Claims 12 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taguchi (US 4360582 A) in view of Fifield (DE 3825782, translation) as applied to claims 1-10, 13-19, 21-25 and 28-36 above, and further in view of Hoffmann (US 4710446). Taguchi as discussed above teaches a photopolymerizable layer comprising a photopolymerization initiator. Taguchi discloses that the kind of initiator to be used is not particularly critical and any known photopolymerization initiator can be used (c. 6, l. 42-45). It is the examiner's position that 2,4,5-triarylimidazole dimer is a well known and conventional photoinitiator. This position is supported by the teachings of Hoffmann which teach that photoinitiator systems conventionally used for resist layer include benzophenone, 2,4,5-triarylimidazole dimers and mixtures thereof (c. 6, l. 9-27).

9. Claims 11 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taguchi (US 4360582 A) in view of Fifield (DE 3825782, translation) as applied to claims 1-10, 13-19, 21-25 and 28-36 above, and further in view of Hatanaka (US 6133343). Taguchi as discussed above teaches a photopolymerizable layer comprising a photopolymerizable monomer. Taguchi discloses that the kind of monomer to be used is an ethylenically unsaturated compound having at least 2 unsaturated bonds in their molecule. It is the examiner's position that one of ordinary skill would have been motivated to use any ethylenically unsaturated monomer, which has at least 2 unsaturated bonds in the taught composition of Taguchi. It is well known in the art that bisphenol A polyoxyalkylene dimethacrylates are polyfunctional compounds. This position is supported by the teachings of Hatanaka which teach that 2,2'-di(4-methacryloxypolyethoxyphenyl) propane, which is a type of Bisphenol A polyoxyalkylene dimethacrylate and trimethylolpropane tri(methyl)acrylate are polyfunctional (meth)acrylates (c. 6, l. 9-28). Taguchi teaches that trimethylolpropane tri(methyl)acrylate

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is a suitable monomer. One of ordinary skill in the art would have been motivated to substitute a 2,2'di(4-methacryloxypolyethoxyphenyl) propane of Hatanaka for the trimethylolpropane tri(methyl)acrylate of Taguchi and expect reasonably similar results. Motivation is based on the concept that similar compounds will produce reasonably similar results.

Response to Arguments

10. Applicant's arguments with respect to the instant claims have been considered but are of little moment in view of the new ground(s) of rejection.

11. The declaration evidence filed on December 11, 2002 has been reconsidered. In the interview of April 2, 2003, the examiner set forth that the declaration evidence showed superior results for a polypropylene film when compared to a polyethylene film. The translated prior art reference to Fifield clearly teaches using covering films of polyamide, polyester vinyl film or cellulose ester film instead of a low density polyethylene film to reduced number of indentations in the resist film. Therefore, one of ordinary skill in the art would have been motivated to optimize the elements of Hilger and Taguchi by avoiding the use of polyethylene covering/protective film and using the materials of Fifield. The examiner notes that the claimed invention does not require a specific material to be used. There is no evidence on the record that the use polypropylene of the instant examples would have superior results when compared to polyamide films, polyester vinyl films or cellulose ester films of Fifield.

12. The examiner further notes that this action is non-final in light of the new grounds of rejection based on the translation of the Fifield prior art reference.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvette C. Thornton whose telephone number is 703-305-0589. The examiner can normally be reached on Monday-Thursday 8-6:30.

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14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C. Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

15. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1495.

16. Please note that the examiner has recently changed her name from "Clarke" to "Thornton".

yct
May 5, 2003



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